

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-14 are pending, with claims 1, 3, 6, and 10 being the independent claims. Claims 1, 3, and 5 have been amended to correct typographical errors and claims 1, 3, 4, 6, 7, 9, and 10 have been amended to clarify the claims. Claims 15-47 are sought to be cancelled as being directed to a non-elected Group, without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejection under 35 U.S.C. § 112

On pages 2-3 of the Office Action, the Examiner rejected claims 3, 4, 10, 11, and 14 under 35 U.S.C. § 112, first paragraph, because the claims allegedly recite "a single means." Without acquiescing to the propriety of this rejection, Applicants have amended the above claims for clarity.

Applicants strongly disagree that claims 3 and 10 as previously pending should have been construed as means-plus-function claims. Rather, both claims recited sufficient structural details to be traditional apparatus claims. A check printer and an apparatus are both proper structures understood in the art, and not merely general means of accomplishing a function. *See Personalized Media Comm. LLC v. Intl. Trade Com'n*,

161 F.3d 696, 704-5 (Fed.Cir.1998) (finding that "digital detector" could not be construed as means-plus-function limitation; "detector" is not generic structural term, but rather had well-known meaning to those skilled in the art).

Also, without acquiescing to the propriety of the rejection, the now amended claims 3 and 10 also clearly recite proper structures understood in the art, and are not merely general means for accomplishing a function.

Applicants respectfully request that the Examiner reconsider and withdraw this rejection and interpret these claims as proper apparatus claims. At least based on their respective dependency to claims 3 and 10, and further in view of their own respective features, claims 4, 11, and 14 also do not recite "a single means." Accordingly, Applicants respectfully request that the rejection of claims 3, 4, 10, 11, and 14 be reconsidered and withdrawn.

Rejection under 35 U.S.C. § 101

On pages 3-4 of the Office Action, the Examiner rejected claims 6-8 under 35 U.S.C. § 101 on the grounds that the Applicants' specification allegedly "does not recite any proper computer readable medium..."

Applicants disagree as there is support in the specification as originally filed for claims 6-8. For example, the following portions of the specification support these claims:

The check printer includes *a processor that executes a hashing algorithm* based on the check preparation information provided to it.

(Originally filed specification at paragraph 0005) (emphasis added).

Upon receipt of this information from the bank 300, the check printer 310 forwards this information to the computer 320. ***The computer 320 executes a hashing algorithm***, such as the CHA algorithm, based on the data passed to it from the check printer 310. The computer 320 may be a computer of the check printer 310, or may be a computer provided by a service or company separate from the check printer 310. The information is passed from the check printer 310 to the computer 320 over communications path 335, which may be an Internet connection, a modem-to-modem computer connection, mail delivery, etc.

The computer 320 generates a one-way hash value using a hashing algorithm and the raw data passed to it from the check printer 310. In the preferred embodiment, the computer 320 generates a 6-digit hash value from the raw data by way of the CHA algorithm. As described above, the raw data used in the first embodiment includes the ABA number, the customer account number, the check number, the hashed value of the Paybond key, and the private data of the customer 330. In the second embodiment, the raw data also includes the product code data.

(Originally filed specification at paragraphs 0035-0036) (emphasis added).

Thus, because the originally filed specification taught, for example, of a processor or a computer ***executing*** a hashing algorithm, the processor or computer would, inherently, include "A computer program product comprising a computer useable medium having computer executable instructions recorded thereon," as recited in claim 6.

These sections of the specification also provide support for claims 7 and 8. Accordingly, Applicants respectfully request that the rejection of claims 6-8 be reconsidered and withdrawn.

Rejection under 35 U.S.C. § 103

On pages 4-5 of the Office Action, the Examiner rejected claims 3-5 and 9-14 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,611,598 to Hayosh (hereinafter, "Hayosh"). Applicants respectively traverse.

Claims 3 and 10 recite features that distinguish over the applied reference. For example, claims 3 and 10 recite printing "a p-bit hash value" on a MICR line of a check.

To establish a *prima facie* case of obviousness, the reference must teach or suggest all the features recited in the claims. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

The Examiner has failed to establish a *prima facie* case of obviousness because: the Examiner has improperly taken what can only be characterized as "Official Notice." Reconsideration and withdrawal of the rejection is therefore respectfully requested.

The Examiner states that "Hayosh fails to discuss the intended use which is *to print and verify the hash value containing [sic] in the MICR line of a check.*" (Office Action, p. 5). Rather, the Examiner states that "Hayosh's computer system is capable of printing and verifying the hash value containing [sic] in the MICR line of a check. Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh's to include the feature above for the purpose of enhancing the security in processing a check." (Office Action, p. 5). Applicants believe the Examiner has taken what can only be characterized as Official Notice for this feature since the Examiner provides no factual evidence to substantiate this conclusionary statement. Also, Applicants respectfully assert that the Examiner has inappropriately taken "Official Notice" of such use of a p-bit hash value because according to the M.P.E.P. at Section 2144.03(A) (emphasis added):

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

In this same Section, the M.P.E.P. then provides some examples of when "official notice" was deemed appropriate:

In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

Applicants assert that the concept of printing "a p-bit hash value" on the MICR line of a check does not fit within one of the narrow exceptions noted by this Section of the M.P.E.P. This Section of the M.P.E.P. also states "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697." Applicants therefore assert that it was inappropriate for the Examiner to take what amounts to "Official Notice" of this concept without providing documentary evidence. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 3 and 10, and find them allowable over the applied reference. Also, at least based on their respective dependencies to claims 3 and 10, and further in view of their own respective features, claims 4, 5, 9, and 11-14 should be allowable over the applied reference. Accordingly, Applicants respectfully request that the rejection of claims 3-5 and 9-14 be withdrawn.

Allowable Subject Matter

Applicants express appreciation to the Examiner for finding claims 1 and 2 allowable over the cited references.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg
Attorney for Applicants
Registration No. 43,447

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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